

REMARKS

In view of the above amendment and the following remarks, reconsideration of the application is respectfully requested. A petition for a three month extension of time is submitted herewith. Claims 2-27 are currently pending in the application. Claims 2-14 and 22-27 are presently before the Examiner. Claim 1 has been canceled without prejudice, and claims 22-27 have been newly added. Support for the amendments to the claims can be found throughout the specification, and may particularly be found, for example at paragraph nos. 23, 46 and 47 of Applicants' published specification (US2005/0149343).

Claim Rejections under 35 U.S.C. § 103

Previously pending Claims 1-14 were rejected as allegedly being obvious over U.S. Patent No. 5,991,751 ("Rivette") alone, or in combination with U.S. Patent No. 6,556,992 ("Barney"). Applicants respectfully traverse the rejections.

Original Claim 1 has been cancelled without prejudice. Claims that previously depended from Claim 1 have been amended to depend from new Claim 22, which recites a computer system that includes means for receiving a query from agents of a law firm, and means, responsive to the received query, for searching at least first and second physical or logical databases for content related to the query. The first database includes a set of work-product documents of the law firm generated by retrieving documents selected from a third database containing work product documents, wherein the retrieved work product documents are converted into a markup language and subsequently indexed based on citations and text to permit the work product documents to be searched by the searching means. The second database, in contrast, includes non-work-product documents of the law firm.

In contrast to new Claim 22, Rivette describes a program for patent centric and group oriented data processing. As best understood, Rivette describes a system that aggregates different types of information relating to patents and product development and permits searching by a user. Rivette fails to teach or suggest a system as recited in new Claim 22, which provides a system having a first database that includes a set of work-product documents of the law firm generated by retrieving documents selected from a third database containing work product documents, wherein the retrieved work product documents are converted into a markup language and subsequently indexed based on citations and text to permit the work product documents to be searched by the searching means. A non-limiting example of such a system can be found in Applicants' specification as published (US2005/0149343) wherein the "DMS" database is the "third" database and the "KMS" database is the "first" database:

[0023] KMS database stores a selected set of high-quality internal work-product documents. In the exemplary embodiment, these documents are copies of documents selected from DMS database 1222. When copied into KMS database 1244, one or more portion of the metadata profile data is also incorporated into KMS database.

[0046] In the exemplary system of FIG. 1, knowledge-management subsystem 120 includes KMS database 1244, which serves as a research repository of documents selected from DMS database 1224. KMS server 1242 includes software (that is, coded instructions) for automatically migrating or mirroring select documents from firm's DMS or network file system to the KMS database 1242.

[0047] In the exemplary embodiment, this migration process initially entails retrieving one or more documents from DMS database, for example, using administrator defined queries and executing those queries on a scheduled basis or event-driven basis. Next, the exemplary method entails converting the retrieved documents into a markup language, such as HTML, subsequently indexing the converted documents based on citations and text. The next series of operations include storing citation relationships, storing the HTML documents with tagged citations, and storing document profile data all in a relevant portion of the KMS server.

The system of Claim 22 therefore defines a system that selects, refines and indexes work product documents in a physical or logical database that is separate and distinct from the database including the source material. As is clear from Claim 22, this operation does not merely represent copying information, but carefully selecting information from a general database of internal work product information and processing it in a specific manner so that it may be efficiently searched in parallel with an outside database.

Rivette does not teach or disclose such a system. Accordingly, it is respectfully submitted that Rivette is not germane to new Claim 22. Similarly, Claims 10, 12 and 13 have been amended herein and new Claim 27 has been added to recite similar features. Moreover, dependent claims 2-9, 11, 14 and 23-27 add additional claimed features that further distinguish these claims from Rivette.

For example, new Claim 23 recites a computer system as Claim 22, wherein the retrieving step is accomplished by automatically migrating or mirroring documents selected from the third database to the second database. New Claim 24 recites such a system wherein the migration process includes retrieving at least one work product document from the third database by using administrator defined queries and executing those queries on a scheduled basis or event-driven basis. New Claim 25 still further specifies that the migration process includes (i) storing citation relationships, (ii) storing the work product documents with tagged citations and (iii) storing document profile data in the second database. Moreover, Claim 26 recites a computer system as set forth in Claim 22, wherein at least a portion of the metadata profile data of the work product documents are incorporated into the converted work product documents on the second database. Rivette does not teach or suggest anything of the kind.

Barney is generally directed to a system that attempts to create a model to identify valuable patents (or characteristics of valuable patents) by comparing patents that were enforced successfully and unsuccessfully. Barney therefore does not remedy the deficiencies of Rivette, and is even less germane to the invention as presently claimed. Applicants therefore request that the rejections under 35 USC §103 be withdrawn and that the pending claims be allowed.

Formal Request For Interview

Applicants respectfully request an interview with the Examiner to discuss the present application and the prior art of record if the Examiner disputes the patentability of the pending claims. Applicants' attorney of record Brian Pollack may be reached at (203) 353-6876 to schedule a mutually convenient date and time and to provide assistance or additional information if required.

CONCLUSION

Applicants respectfully request allowance of this application. The Director is hereby authorized to charge any fee deficiency associated with this paper (or with any paper filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 85192(307534).

Respectfully submitted,

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